



## SCHEEF & STONE, L.L.P.

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Jack D. Stone, Jr.

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P.O. Box 1450  
Alexandria, VA 22313-1450

Docket No: NC28050-D2 (9015.086)

### TRANSMITTAL

In re: U.S. Serial No. 10/092,209  
Inventor: Erkki Tanskanen, Vantaa  
Title: Mobile Lottery Games Over a Wireless Network

Dear Sir:

Please find enclosed:

1. Appellant's Brief on Appeal (7 pages, in triplicate);
2. Appendix (5 pages);
3. Return post card.

Respectfully submitted,

Dated: November 1, 2004

By: 

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AF/3713  
JFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/092,209  
Applicant : ERKKI TANSKANEN, VANTAA  
For : MOBILE LOTTERY GAMES OVER A WIRELESS NETWORK  
Filed : March 6, 2002  
TC/A.U. : 3713  
Examiner : Nguyen, Kim T.  
Docket No. : NC28050-D2 (9015.086)  
Customer No. : 30973

Confirmation No. 7727

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on November 1, 2004

Jack D. Stone, Jr.

**APPELLANT'S BRIEF ON APPEAL**

Dear Sir:

This brief is submitted in triplicate on behalf of Appellant for the application identified above. The Commissioner is hereby authorized to charge any fees which may be required pursuant to this Brief, or credit any overpayment, to Deposit Account No. 50-2032 of Scheef & Stone, L.L.P.

**REAL PARTY IN INTEREST**

The real party in interest for this appeal is the assignee of the application, Nokia Corporation.

**RELATED APPEALS AND INTERFERENCES**

There are no currently-pending appeals or interferences related to the present application.

### **STATUS OF CLAIMS**

In the final Office action dated January 28, 2004, Claims 1-5, 8, 10-14, 16-21, 23-26, 28, 34, and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,816,919 to Scagnelli et al. (hereinafter "*Scagnelli*").

Claims 18, 24, 34, and 35 stand objected to for certain informalities. Applicant will make appropriate amendments upon allowance of the application to issue.

Claims 17, 34, and 35 stand rejected under 35 U.S.C. § 112, second paragraph. Applicant will make appropriate amendments upon allowance of the application to issue.

Appeal is made of the rejection of all of the claims, *i.e.*, Claims 1-5, 8, 10-14, 16-21, 23-26, 28, 34, and 35 under 35 U.S.C. § 103(a).

### **STATUS OF AMENDMENTS**

No amendments to the claims have been filed subsequent to the final Office action dated January 28, 2004.

### **SUMMARY OF THE INVENTION**

The present invention is directed to a method of providing electronic lottery games over a wireless network from a electronic betting service to a wireless game terminal (202) having a display and button array (302). Accordingly, a game identification number is transmitted over a wireless network to a wireless game terminal (202). A plurality of game parameters associated with the game identification number are transmitted over the wireless network to the wireless game terminal (202), wherein the game parameters comprise a button array (302) configuration and a game display layout for said display. Data related to selections on the wireless game terminal associated with the game identification number is received. A win/loss value is calculated (110) at the electronic betting service, and is transmitted to the wireless game terminal.

## ISSUES

Whether Claims 1-5, 8, 10-14, 16-21, 23-26, 28, 34, and 35 are unpatentable under 35 U.S.C. § 103(a) over *Scagnelli*.

## GROUPING OF CLAIMS

For purposes of this appeal, the pending claims will be grouped together as a single group.

## ARGUMENTS

Claims 1-5, 8, 10-14, 16-21, 23-26, 28, 34, and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Scagnelli*. Appellant respectfully traverses.

As specifically claimed in independent Claims 1 and 10, and similarly in independent Claim 18, Appellant's invention includes *et alia*, "game parameters comprising button array configuration and a game display layout for said *display*" (emphasis added). The distinguishing feature provides Appellant's invention with many advantages over the prior art, such as being able to receive game data amounting to an electronic game ticket such as a "scratch-game" ticket. In physical form, a scratch game ticket provides the player with a card having one or more areas covered by a removable substance that hides what is printed underneath. The user plays the game by scratching off the removable substance to reveal the hidden portion of the card. This then informs the player whether and what or how much has been won. Note that the user may simply uncover whatever hidden areas exist, or may be presented with an outcome determinative choice, where the prize won depends on which of a plurality of areas the player chooses to reveal (no prize being awarded if the player 'cheats' by revealing too many hidden areas). Any winnings are usually collected from the vendor or through some other redemption process.

In clear contrast to Appellant's claimed invention, *Scagnelli* is seen to disclose a method for purchasing lottery tickets over the telephone, which is referred to as "processing lottery wagers" (*Scagnelli* at col. 1, lines 18-20). The process is automated by handling wager calls through an automatic call director (ACD) that provides a list of recorded choices that are read to the caller, who can then select lottery numbers using the telephone keypad (*Scagnelli*) at col. 2, lines 5-42). The disclosed system also includes a means for setting up a wagering account, charging a credit card for purchases, and the like. It does not, however, disclose the wireless station of the present invention (despite its discussion of telephones, and even a passing reference to wireless phones).

Playing a lottery, as understood in *Scagnelli*, simply involves buying a ticket. The user must pick a set of numbers, or elect to have a machine assign numbers at random. In *Scagnelli*, this is all accomplished by placing a phone call to the ACD. Even if this is done using a wireless telephone, no game information is transmitted to the phone, except as is needed for the purchase of "conversation" between the buyer and the ACD (and the associated voice response units).

In the final Office action dated January 28<sup>th</sup>, 2004, the Examiner asserts that "a cellular telephone having a display and button array would have been well known" (page 3, lines 3-4). While such may have been well known, Appellant asserts that *Scagnelli* neither teaches nor suggests combining a display and button array with a telephone to display game parameters comprising a button array configuration and a game display layout. Because *Scagnelli* is rather directed to *buying* lottery tickets in response to automated prompts on the telephone, there would be *no motivation* for incorporating a display for game parameters, as discussed above. Even if, for the sake of argument, there were motivation, it is unclear *how* the display would utilized by *Scagnelli* in light of what it is designed to do.

It is well established that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found in either the references themselves or in the knowledge

generally available to one of ordinary skill in the art<sup>1</sup>. The Examiner must show *reasons* that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. In other words, there must be an explanation of the reasons, not just opinion, that one of ordinary skill in the art would have been *motivated* to select the references and to combine them to render the claimed invention obvious.<sup>2</sup> However, the Examiner has failed to provide the suggestion or any motivation for combining a display with *Scagnelli*. And while the teaching, suggestion, or motivation to combine may be found in knowledge generally available to one of ordinary skill in the art, it is rare that the skill in the art component will operate to supply the missing knowledge or prior art to reach an obviousness judgment.<sup>3</sup> While prior art references themselves may supply the requisite teaching, suggestion, or motivation to combine, the references (including general knowledge in the present case) cited by the Examiner are void of such teaching, suggestion, or motivation. It is, therefore, respectfully submitted that the mere opinion of the Examiner as a basis for combining a display with *Scagnelli* fails to meet the Examiner's burden to show the requisite teaching, suggestion, or motivation to combine. In light of the foregoing, such motivation is clearly lacking, thereby effectively negating any charges of obviousness.

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<sup>1</sup> *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

<sup>2</sup> *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). In this case, the Board of Appeals simply invoked the high level of skill in the art to provide the necessary motivation to combine. It did not, however, explain what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested combination. If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance. Instead, in complex scientific fields, the Board could routinely identify the prior art elements in an application, invoke the lofty level of skill, and rest its case for rejection. To counter this potential weakness in the obviousness construct, the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness. Because the Board did not explain the specific understanding or principle within the knowledge of a skilled artisan that would motivate one with no knowledge of the invention to make the combination, the court infers that the examiner selected these references with the assistance of hindsight. But the law forbids the use of hindsight in the selection of references that comprise the case of obviousness. Lacking a motivation to combine references, the Board therefore did not show a proper prima facie case of obviousness.

<sup>3</sup> *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161, 1171 (Fed. Cir. 1999).

In summary, any motivation to combine a display with *Scagnelli* is clearly lacking, thereby effectively negating any charges of obviousness. Accordingly, it is respectfully submitted that the rejections by the Examiner based upon these references cannot stand and it is respectfully requested that they be overruled.

### CONCLUSION

In view of the foregoing, it is apparent that *Scagnelli* does not teach, suggest, or render obvious the unique combination now recited in independent Claims 1, 10, and 18. It is therefore respectfully submitted that Claims 1, 10, and 18 clearly and precisely distinguish over the cited reference in a patentable sense, and are therefore allowable over that reference and the remaining references of record. Accordingly, it is respectfully requested that the rejection of Claims 1, 10, and 18 under 35 U.S.C. § 103(a) as being unpatentable over *Scagnelli* be withdrawn.

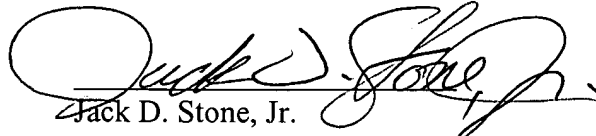
Claims 2-5, 8, 11-14, 16, 17, 19-21, 23-26, 28, 34, and 35 depend from and further limit independent Claims 1, 10, and 18, in a patentable sense, and, for this reason and the reasons set forth above, are also deemed to be in condition for allowance. Accordingly, it is respectfully requested that the rejections of dependent Claims 2-5, 8, 11-14, 16, 17, 19-21, 23-26, 28, 34, and 35 be withdrawn, as well.

Appl. No. 10/092,209  
Appeal Brief dated November 1, 2004  
Response to final OA of January 28, 2004

Applicant respectfully requests that the Board of Appeals reverse the decision of the Examiner in which all of the pending claims of the Application were rejected, so that the application may be passed to issue.

Respectfully submitted,

Dated: November 1, 2004

  
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## APPENDIX

### CLAIMS ON APPEAL

1. A method of providing electronic lottery games over a wireless network from a electronic betting service to a wireless game terminal having a display and button array, comprising the steps of:

transmitting a game identification number over said wireless network to said wireless game terminal;

transmitting a plurality of game parameters associated with said game identification number over said wireless network to said wireless game terminal, wherein the game parameters comprising button array configuration and a game display layout for said display;

receiving data related to selections on said wireless game terminal associated with said game identification number;

calculating a win/loss value at said electronic betting service; and

transmitting said win/loss value to said wireless game terminal.

2. The method of Claim 1, further comprising the step of transmitting a selection of possible games wherein said game identification number and said plurality of game parameters are associated with a game selected from said possible games.

3. The method of Claim 1, further comprising the step of crediting an account when said win/loss value is a positive value.

4. The method of Claim 1, wherein said calculating step occurs after said receiving step.

5. The method of Claim 1, wherein said calculating step is performed for each possible selection associated with said game identification number.

6. (cancelled).

7. (cancelled).

8. The method of Claim 1, further comprising the step of storing information associated with said game identification number on a database.

9. (cancelled).

10. A method of playing electronic lottery games over a wireless network on a wireless game terminal having a display and button array, comprising the steps of:

accepting a lottery game selection from said wireless network;

receiving a game identification number and a plurality of game parameters associated with said game identification number from said wireless network, wherein said plurality of game parameters comprising button array configuration and a game display layout for said display;

accepting at least one gaming selection from said wireless network according to the rules of said selected lottery game; and

receiving win/loss value information from said wireless network based on said at least one gaming selection.

11. The method of Claim 10, further comprising the step of logging on to said wireless network to receive a selection of lottery games.

12. The method of Claim 10, further comprising the step of crediting an account when said win/loss value is a positive value.

13. The method of Claim 10, further comprising the step of storing information about said at least one gaming selection on a database.

14. (original) The method of Claim 10, further comprising the step of calculating a win/loss value for said selected game.

15. (cancelled)

16. The method of Claim 10, further comprising the step of calculating a win/loss value for each possible gaming selection of said selected game.

17. The method of Claim 10, wherein said steps are in the form of instructions embodied in a carrier wave sent over said wireless network to instruct said wireless game terminal to perform said steps.

18. An interactive services display and response system for providing games over a wireless network, comprising:

a betting service provider on said wireless network; and

a wireless game terminal connected to said wireless network to communicate with said betting service provider over said wireless network;

wherein said betting service provider is configured to transmit a game identification number over said wireless network to said wireless game terminal, transmit a plurality of game parameters associated with said game identification number to said wireless game terminal, receive data related to selections on said wireless game terminal associated with said game identification number, calculate a win/loss value, and transmit said win/loss value to said wireless game terminal; and

wherein said wireless game terminal is configured to accept a lottery game selection, receive said game identification number and said plurality of game parameters associated with said number, accept at least one gaming selection according to the rules of said selected lottery game, and receive said win/loss value based on said at least one gaming selection.

19. The system of Claim 18, wherein said betting service provider is further configured to transmit a selection of possible games wherein said game identification number and said plurality of game parameters are associated with a game selected from said possible games.

20. The system of Claim 18, wherein said betting service provider is further configured to credit an account when said win/loss value is a positive value.

21. The system of Claim 18, wherein said betting service provider is further configured to calculate a win/loss value for each possible selection associated with said game identification number.

22. (cancelled)

23. The system of Claim 18, further comprising a database which stores information associated with said game identification number.

24. The system of Claim 18, wherein said wireless game terminal is further configured to log on to said wireless network to receive a selection of lottery games.

25. The system of Claim 18, wherein said wireless game terminal is further configured to credit an account when said win/loss value is a positive value.

26. The system of Claim 18, wherein said wireless game terminal is further configured to calculate a win/loss value for said at least one gaming selection.

27. (cancelled).

28. The system of Claim 18, wherein said game terminal configuration is a software configuration.

29 – 33. (cancelled).

34. The method of Claim 10, wherein said steps are in the form of instructions embodied in flash memory to instruct said wireless game terminal to perform said steps.

35. The method of Claim 10, wherein said steps are in the form of instructions embodied in flash memory to instruct said wireless game terminal to perform said steps.